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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060428
Party	Plaintiff Quality Bicycle Products, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration Nos. 4496120 and 4414967

For the Marks  and **45NORTH**

Registered on October 8, 2013 and March 11, 2014

QUALITY BICYCLE PRODUCTS, INC.,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92060428
	:	
MIDDLEBROOK DESIGN LLC	:	
dba LOVE TRAVERSE CITY,	:	
	:	
Registrant.	:	

**PETITIONER’S RESPONSE TO REGISTRANT’S MOTION FOR SUMMARY
JUDGMENT, AND REQUEST THAT SUMMARY JUDGMENT INSTEAD BE
ENTERED IN FAVOR OF PETITIONER**

Quality Bicycle Products, Inc. (“Petitioner” or “QBP”) submits this memorandum in opposition to Registrant’s December 4, 2015 Cross Motion for Summary Judgment.¹ At this juncture, all of the summary judgment papers on file show that a likelihood of consumer confusion *exists* between the at-issue marks. On the record before it, the Board should deny Registrant’s requested relief and instead find that QBP is entitled to summary judgment in its favor on its Petition to Cancel. This brief is submitted pursuant to 37 C.F.R. § 2.127(a).

¹ Under a literal reading of the Rules, Registrant’s December 4, 2015 Cross Motion for Summary Judgment could be denied and refused as untimely filed. A November 19, 2015 Order issued suspending the proceedings. It was not until December 4, 2015, however, that Registrant filed its Cross Motion for Summary Judgment on QBP’s Cancellation claim as part of its Response to QBP’s Motion on the Counterclaim. That said, QBP respectfully requests that the Board decide Registrant’s motion on the merits.

I. INTRODUCTION

As detailed in the underlying summary judgment papers, QBP's priority is unrefuted. QBP began use of its 45NORTH marks well before the Registrant began use of the designations at issue, and well before Registrant's filing dates for the Registrations at issue in this proceeding. It is undisputed that time-wise priority belongs to QBP.

Further, now that the likelihood of confusion analysis is subject of the summary judgment papers and proceedings, the undisputed facts demonstrate that a likelihood of confusion conclusively exists. As shown here, the marks appear to be nearly identical:



As explained more fully herein, the evidence of sales, advertising, and years of use establishes that the QBP 45NORTH marks have relative fame. Meanwhile, the goods, channels of trade, and customers are the same. On less of a record in the underlying prosecution, the

² November 2, 2015 Declaration of Audrey J. Babcock ("Nov. 2015 Babcock Dec.") (Dkt. 9) Ex. A, p. 7; Registrant's Mem., p. 6; January 21, 2016 Affidavit of Audrey J. Babcock ("Jan. 2016 Babcock Aff.") Ex. A; Affidavit of David Gabrys ("Gabrys Aff.") (Dkt. 12) Ex. E & Registrant's Mem., p. 7; Jan. 2016 Babcock Aff. Ex. B, respectively.

Examiner already found a likelihood of confusion between the marks. Summary judgment should be entered in favor of QBP on its Petition to Cancel.

II. RELEVANT FACTUAL BACKGROUND

A. QBP Filed the Application Which Matured Into its First 45NRTH Registration in 2012.

QBP, which was founded in Saint Paul, MN, named its 45NRTH line after the 45-degree latitude line that crosses the Twin Cities. (January 20, 2016 Declaration of Scott G. Patterson (“Patterson Dec.”) ¶ 3.) QBP is the owner of U.S. Trademark Registration No. 4268136 (45NRTH), which was filed on May 15, 2012 and registered on the Principal Register on January 1, 2013, for use in connection with “bicycle parts, namely tires” in International Class 12. (Compl. ¶ 3 & Ex. A; Nov. 2015 Babcock Dec. Ex. A.) The registration is valid and subsisting. (*Id.* See also Nov. 2015 Babcock Dec. Ex. C.)

B. Since the Beginning, QBP has Used its 45NRTH Marks on Clothing.

Before Registrant first offered in commerce any goods with the marks at issue in this proceeding, QBP was selling in interstate commerce clothing, footwear, and headwear bearing its 45NRTH marks. (Compl. ¶ 1.)³

C. Since the Beginning, QBP has Sold its 45NRTH Products in Brick and Mortar Stores, Including One in Traverse City, Michigan.

In October of 2011, QBP began distributing its products bearing its 45NRTH marks to brick-and-mortar stores. (Patterson Dec. ¶ 8.) One such store is Einstein Cycles, located in

³ Indeed, QBP’s November 2, 2015 Motion (Dkt. 9) shows that QBP has sold clothing, headwear, and footwear under its 45NRTH mark and 45NRTH design mark (45NRTH) (collectively, “45NRTH marks”) since early 2012. (*See, e.g.*, Gabrys Aff. ¶ 5 & Ex. B.) QBP first sold socks, with sales beginning on March 12, 2012, and then sales of other goods in Class 25 followed. (Gabrys Aff. ¶¶ 5-10 & Ex. B.) For example, the first sale of the 45NRTH Jaztronaut insole was on September 18, 2012. (Gabrys Aff. ¶ 10 & Ex. B.) The first sale of the 45NRTH Lung cookie balaclava, as well as the 45NRTH Toaster Fork balaclava/cap, was on October 25, 2012. (Gabrys Aff. ¶¶ 8-9 & Ex. B.)

Traverse City, Michigan. (Patterson Dec. ¶ 9.) On December 5, 2011, Einstein first purchased a QBP product bearing the 45NRTH mark. (Patterson Dec ¶ 9 & Ex. C; *See also* Nov. 2015 Babcock Dec. Ex. D.) On November 28, 2012, Einstein first purchased a piece of clothing bearing the 45NRTH mark. (Patterson Dec. ¶ 9 & Ex. C. *See also* Nov. 2015 Babcock Dec. Ex. D.)

Today, Einstein still sells QBP's goods bearing the 45NRTH mark. (Patterson Dec. ¶ 9.)

D. QBP has Spent Resources to Develop its Marks and Create Relative Fame.

Over the course of more than four years, QBP has invested in its marks to build significant goodwill. (Compl. ¶ 2; Patterson Dec. ¶¶ 10-16.) QBP has created great brand recognition and goodwill by creating high-quality goods and generating an advertising buzz around the brand. The 45NRTH marks are in QBP's online sales catalog (Gabrys Aff. ¶¶ 11-19 & Exs. C-D), on its website (Gabrys Aff. ¶ 25 & Ex. N), and on its product hangtags. (Gabrys Aff. ¶ 26 & Exs. O-P.) QBP has advertised its marks on its Facebook page (Gabrys Aff. Ex. Q), through Internet press releases (Gabrys Aff. Ex. R), and in magazines. (Gabrys Aff. Ex. S. *See also* Patterson Dec. ¶ 12.) QBP also has sponsored numerous events in North America, including Michigan. (Patterson Dec. ¶ 13.) During these sponsored events, QBP typically provides products—including 45NRTH products—as prizes, and displays its 45NRTH marks (logos) on the event website and at the event's venue. (Patterson Dec. ¶ 13.) Between June of 2012 and today, QBP has spent [REDACTED] in marketing expenses relating to its 45NRTH Goods. (Patterson Dec. ¶ 14 & Ex. E.)

In sum, QBP's 45NRTH marks have come to represent the highest-quality goods and consumers have come to count on QBP's 45NRTH marks to represent superior clothing, footwear, and headwear complementary to its bicycle parts and bicycling gear products. (Patterson Dec. ¶ 16. *See also* Gabrys Aff. ¶¶ 5-7.)

E. Registrant's Designations Are Confusingly Similar.

Meanwhile, Registrant adopted its designation well after QBP's marks were in use, with the explanation: "[w]e wanted a fresh and unique way to show our love for Traverse City and Michigan, rather than having to resort to wearing low quality, boring and mass produced touristy t-shirts. So, we decided to create original, locally inspired designs and print them on the highest quality and most comfortable garments we could find." (Patterson Dec. Ex. H; Registrant's website at <http://www.lovetraversecity.com/about>.) Registrant's designations, however, are confusingly similar and appear to be nearly identical to QBP's 45NORTH marks and registration:



An analysis of the *DuPont* factors demonstrates that there *exists* a likelihood of consumer confusion between the at-issue marks. Registrant's Motion should be denied, and the Board should grant Summary Judgment in favor of QBP on its Petition to Cancel.

⁴ Nov. 2015 Babcock Dec. Ex. A, p. 7; Registrant's Mem., p. 6; Jan. 2016 Babcock Aff. Ex. A; Gabrys Aff. Ex. E & Registrant's Mem., p. 7; Jan. 2016 Babcock Aff. Ex. B, respectively.

III. ARGUMENT

A. Standard of Review.

“A party may move for summary judgment, identifying each claim or defense — or the part of each claim or defense — on which summary judgment is sought. The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). “After giving notice and a reasonable time to respond, the court may...grant summary judgment for a nonmovant.....” Fed R. Civ. P. 56(f). “If the Board concludes, upon motion for summary judgment, that there is no genuine dispute of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, after giving notice and a reasonable time to respond, in appropriate cases, grant summary judgment in favor of the nonmoving party (that is, enter summary judgment in favor of the nonmoving party even though there is no cross motion for summary judgment).” TBMP 528.01.

Under the Lanham Act:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it---... Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....



15 U.S.C. § 1052(d). “Under the statute, the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of the marks of an applicant and a prior user on their respective goods.” *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). As such, for QBP to prevail in its Petition to Cancel, it must establish priority of use, as well as likelihood of confusion between the marks at issue. The determination of prior use will be decided by the Board in regard to QBP’s November 2, 2015 Motion for


Summary Judgment on Registrant's Counter-Claim. (Dkt. No. 9.) This brief will detail the likelihood-of-confusion factor.




The Board's "likelihood of confusion determination under Section 2(d) is a legal conclusion, based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue." *Wolverine Outdoors, Inc. v. Marker Volkl (Int'l) GMBH et al*, Opposition Nos. 91161363; 91177732; 91177736, 2013 WL 5655832, at *12 (TTAB Sept. 30, 2013). Those thirteen factors are set forth in *DuPont*, 476 F.2d at 1377. "Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods or services." *In re Hotline Sales Corp.*, 2002 WL 1301773 (TTAB June 12, 2002). "[T]he determination of a likelihood of confusion does not require examination and findings as to each and every *DuPont* factor." *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002). Despite Registrant's contention that only three of those factors are relevant to the present case (Registrant's Mem., p. 8), QBP details seven factors, and demonstrates how each of those factors support a finding in favor of QBP, below.

B. QBP is Entitled to Summary Judgment Because the Undisputed Facts Demonstrate That There Is a Likelihood of Consumer Confusion Between the Marks.




1. *The marks are the same in appearance, sound, connotation, and commercial impression.*

The first *DuPont* factor, "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression," weighs heavily in favor of QBP. *DuPont*, 476 F.2d at 1361. The marks  and **45[®]NORTH** are substantially similar in all of these characteristics to 45NORTH and .

Without much specificity, Registrant contends that this case is similar to the Board's decision in *In re Covalinski*, 113 U.S.P.Q.2d 1166, 2014 WL 7496055 (TTAB 2014). (Registrant's Mem., p. 10.) However, this is not so. In *Covalinski*, the Board compared marks that were significantly more dissimilar than the ones presented in this proceeding. There, the Board compared the mark  of Redneck Racegirl and found that it was not similar to the mark RACEGIRL, even though the RRs in the designer mark contained the words "edneck" and "acegirl." *Id.* at *3. Among other notable design elements, the Board found that the design mark "includes very large, prominently displayed letters RR" and that the "bodies of the Rs are filled with a checkerboard pattern resembling a racing flag." *Id.* The Board found that "[t]ogether, these graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the 'a-c-e' of the word 'RACEGIRL' **difficult to notice.**" *Id.* (emphasis added.)

Unlike the design mark in *Covalinski*, nothing in Registrant's  and **45°NORTH** marks makes the 45NORTH and  element of the marks *difficult to notice*. In fact, a viewer seeing Registrant's marks would *immediately* read "45 North." That same viewer would also read "45 North" when viewing QBP's 45NRTH and  marks. Indeed, the Board has recognized that when evaluating marks that contain both words and design, the words should be given more weight, as the *words* are how purchasers associate the product to the mark. *See E.I. duPont de Nemours & Co.*, 2001 WL 1182789, at *8 (TTAB Sept. 27, 2001) ("With respect to opposer's DUPONT mark and applicant's DUPONT REGISTRY and design mark in particular, we note that when one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods.") Finally, "[t]he test is not whether the marks can be distinguished when subjected to a side-by-

side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.” *In re Am. Blanching Co.*, 2008 WL 2817085, at *2 (TTAB July 10, 2008).


In addition, Registrant argues that the marks at issue in this proceeding are dissimilar because: (1) Registrant’s marks feature a degree symbol, (2) Registrant’s marks contain an “O,” and (3) Registrant’s marks have different connotations than those of QBP. (Registrant’s Mem., p. 11.) These arguments will be addressed in turn. While it is true that Registrant’s  and **45°NORTH** marks contain a small degree symbol (°), that symbol does not render those marks dissimilar from QBP’s 45NRTH mark. The Board has previously held that small design elements or symbols added to otherwise similar marks do not render the marks dissimilar. *See, e.g. In re Elbaum*, 211 U.S.P.Q. 639, 1981 WL 40489, at *2 (TTAB 1981) (finding a likelihood of confusion between “CIRCUL+AID” and “CIRCULADE” and holding, “the issue here is not whether ‘CIRCUL+AID’ is a different mark than “CIRCUL AID” when registered to the same person. It is whether the ‘+’ is a sufficient distinguishing feature in applicant's mark to obviate the likelihood of purchaser confusion with the registered mark, ‘CIRCULADE’. We think that it is not.”); *The Sunrider Corp. v. Shoban Lal Jain*, 2009 WL 4081698, at *7 (TTAB Oct. 15, 2009) (finding marks OLINA and OI-LIN to be substantially the same or similar and likely to cause confusion and holding, “nor does the presence of the hyphen in opposer's mark suffice to distinguish the marks in terms of appearance when they are considered in their entireties” and citing cases); *In re Hotline Sales Corp*, 2002 WL 1301773, at *1 (TTAB June 12, 2002) (finding that AGACCI and A’GACI were substantially the same or similar and likely to cause confusion “because they are similar in appearance and could be pronounced the same way”). Registrant’s addition of a “°” symbol does not make **45°NORTH** or  substantially dissimilar from **45NRTH** .

or 45NORTH. In each mark, the primary elements are the numbers “45” and the word “North.” Registrant’s “°” symbol does not save it from summary judgment in favor of QBP.

What is more, the fact that Registrant’s marks contain an “O” does not render the marks dissimilar. As an initial matter, Registrant already conceded that, “[f]or purposes of determining whether a likelihood of confusion exists between two marks, the overall *visual* impression of the marks derived from viewing the marks in their entireties is controlling.” (Registrant’s Mem., p. 9 (emphasis added).) Moreso, the Board has routinely held that the addition or change of a vowel does not make two otherwise similar marks dissimilar. *See In re Marichem Marigases Hellas Ltd.*, 2003 WL 169756, at *4 (TTAB Jan. 22, 2003) (finding the marks “MIRACHEM and MARICHEM” substantially similar despite the fact that they differed in the “transposition of the first two vowels”); *In re Trademark Mgmt. Co.*, 2005 WL 3175099, at *2 (TTAB Nov. 9, 2005) (“The only difference between these two marks is the final letter, an ‘A’ in the registration and an ‘O’ in the application. The marks would be very similar in sound and appearance.”) Regardless of the letter “O,” the sound and appearance of the marks at issue in this proceeding are substantially the same or similar and are thus likely to cause consumer confusion.

Finally, Registrant argues that, even if the marks are similar in appearance or sound, differences in *connotation* could be enough to eliminate consumer confusion. (Registrant’s Mem., p. 11.) However, this is a red herring. Contrary to Registrant’s uncited assertions, QBP, which was founded in Saint Paul, MN, named its 45NORTH line after the 45-degree latitude line that crosses the Twin Cities. Patterson Dec. ¶ 3. As such, the parties to this proceeding use their marks in an attempt to convey the exact same commercial impression. (See Registrant’s Mem., p. 12 (“Registrant’s marks are designed to purposefully call to mind the local area of the Registrant, namely, Traverse City Michigan. Traverse City is located on the 45 parallel.”).)

What is more, both sets of marks have the same “commercial impressions because they are similar in appearance, could be pronounced the same way, and are associated with the same types of goods.” See *In re Hotline Sales Corp.*, 2002 WL 1301773, at *1 (TTAB June 12, 2002). In addition, the cases cited by Registrant for this argument are off point. For example, in *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987), the parties had a consent agreement, whereby they had agreed that each party could use a similar mark on similar types of products. No such agreement exists here. In addition, a Google search of “45North” with an “O” (like Registrant’s marks) provides results relating to QBP’s products. (Patterson Dec. ¶ 10 & Ex. D.) The marks are indeed the same or similar.

In the cases addressed herein, the question was whether “the points of similarity between the marks outweigh the points of dissimilarity.” See, e.g., *The Sunrider Corp.*, 2009 WL 4081698, at *7. In this proceeding, the similarities between Registrant’s  and **45NORTH** marks and QBP’s 45NRTH marks vastly outweigh any differences. This factor weighs in support of QBP’s Petition to Cancel.

2. The goods are the same.

The second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use,” also weighs in favor of QBP. *DuPont*, 476 F.2d at 1361. QBP and Registrant both use their marks on clothing. Among other things, QBP uses its 45NRTH marks on socks, **t-shirts**, shoes, **caps**, balaclavas, and insoles. (Gabrys Aff. ¶ 4 & Ex. B; Patterson Dec. ¶ 11.) Likewise, Registrant uses its mark on clothing, including “**t-shirts**, long sleeved shirts, sweatshirts, and **hats**.” (Registrant’s Mem., p. 2 (emphasis added).) Registrant avoids these overlaps and argues, without support, that Registrant’s “headwear” or “t-shirts” are “not related and of a fundamental

different nature than” QBP’s products, because QBP also makes bike products. (See Registrant’s Mem., p. 14.) However, Registrant’s own brief includes a photograph of a t-shirt bearing QBP’s **45N RTH** mark. (Registrant’s Mem., p. 6.) Accordingly, any argument that Registrant and QBP do not make overlapping products should be rejected.

In that same vein, the caselaw put forth by Registrant, which goes to instances when parties sold *different* types of products (*see, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990), in which the Board deemed drain opener product different than design for plumbing-related advertising) is inapposite: QBP and Registrant sold the exact same products—namely, t-shirts and hats—bearing the same or substantially similar marks. The fact that QBP also sells bicycle goods, or other types of clothing in Class 25, does not mean that there is no likelihood of confusion: “confusion may be likely when only one item in a class of goods is commercially similar to the registrant’s goods.” *In re Marichem Marigases Hellas Ltd.*, 2003 WL 169756, at *4 (TTAB Jan. 22, 2003) (*citing Tuxedo Monopoly, Inc. v. Gen. Mills Fun group, Inc.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).)

What is more, even if the products did not directly compete with each other, such fact would not be dispositive: “[t]he marks need not be used on directly competing goods, **any relation likely to lead purchasers into assuming a common source being sufficient.**” *Dan Robbins & Assoc., Inc. v. Quwestor Corp.*, 599 F.2d 1009, 1013, 202 USPQ 100 (CCPA 1979) (emphasis added). And, of course, the marks need not be fixed on all of the same products to lead to a finding of likelihood of confusion. “Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some

way associated with the same producer or that there is an association between the producers of each parties' goods or services.” *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1991 WL 325859, at *1 (TTAB Feb. 1, 1991).

Because the marks are nearly identical and because QBP and Registrant both affix their marks on overlapping goods, it is reasonable to believe that consumers will likely be confused about the source of these goods.

3. *The trade channels are the same.*

Another *DuPont* factor, “[t]he similarity or dissimilarity of established, likely-to-continue trade channels,” weighs in favor of QBP. *DuPont*, 476 F.2d at 1361. Registrant does not address this factor in its Brief. (See Registrant’s Mem., p. 8.) Indeed, this omission is likely because Registrant is aware that both QBP and Registrant sell their products in brick-and-mortar shops—including brick-and-mortar shops in the same city—and online.

Registrant and QBP both sell their products in brick-and-mortar shops in Traverse City, Michigan. (Registrant’s Mem., p. 1 (Registrant sells its products in a “400 square foot brick and mortar retail store in the Downtown district of a small resort town called Traverse City, Michigan.”).) To attract customers to its Traverse City store, Registrant advertises its products in Michigan tourist maps. (Jan. 2016 Babcock Aff. Ex. E (Registrant’s Response to Interrogatory No. 11).) Like Registrant, QBP sells its products in a brick-and-mortar shop located in Traverse City, Michigan: Einstein Cycles. (Patterson Dec. ¶ 9. See also Nov. 2015 Babcock Dec. Ex. D (Doc. 171).) In fact, Einstein is only 4.8 miles away from Registrant’s store. (*Id.*) Einstein began selling QBP’s products bearing the 45NORTH marks in 2011 and continues to sell them there today. (*Id.*) Registrant asserts that its marks are directed toward people in Michigan, *i.e.*, “tourists visiting the region,” as well as “locals.” (Registrant’s Mem., p. 2.) As is the case for Registrant, Michigan is a “key market” to QBP’s sales: in 2012, Michigan


was identified as one of QBP's "key markets" and represented 10% of the company's market, which was the second-highest market for all of QBP's 45NORTH products. (Patterson Dec. Ex. B.) Today, Michigan remains one of QBP's key markets for its 45NORTH marks, representing QBP's third-highest market for all-time sales of 45NORTH goods, as well as sales in 2015. (Patterson Dec. Ex. G.) What is more, QBP's "target market" is bicyclists who "live in climates," like Michigan's, "with two or more consistent months of temperatures below freezing." (Patterson Dec. Ex. A.)

Also, Registrant and QBP both sell their products online. (Patterson Dec. ¶¶ 6-7.) Registrant sells products bearing its marks on two websites: www.lovetraversecity.com and 45degrees-north.com. (Jan. 2016 Babcock Aff. Ex. E (Registrant's Response to Interrogatory No. 11(1)).) QBP's 45NORTH products are sold by online retailers, including Backcountry.com and Treefortbikes.com, which is located in Michigan. (Patterson Dec. ¶ 7.) Finally, because Registrant's and QBP's goods are closely related, it is presumed that their channels of trade are similar. *See In re Marichem Marigases Hellas Ltd.*, 2003 WL 169756, at *4 (TTAB Jan. 22, 2003).

This *Dupont* factor weighs in favor of finding a likelihood of confusion and granting summary judgment in favor of QBP on its Petition to Cancel.

4. *The conditions under which and buyers to whom sales are made are the same.*

The fourth *DuPont* factor, "[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing," weighs in favor of QBP. *DuPont*, 476 F.2d at 1361. While it is true that QBP sells high-end, expensive bicycle products, it, like Registrant, also sells clothing, including socks, t-shirts, and hats, priced at rates that cater to "impulsive" purchases. For example, QBP sells 45NORTH t-shirts for \$25-\$60 and its 45NORTH

hats cost \$30-\$45. (Patterson Dec. ¶ 11.) Likewise, Registrant sells its t-shirts bearing the  and **45NORTH** marks for \$25 and its hats bearing those marks range from \$20-\$25. (See Jan. 2016 Babcock Aff. Exs. A & B (print outs from Registrant’s website).) These items would lead to consumer confusion. *Compare*



The fact that QBP’s products are of high quality does not change this analysis: as demonstrated, the cost of QBP’s 45NORTH clothing goods is relatively inexpensive and Registrant itself touts its products as high quality. (See Patterson Dec. Ex. H (Registrant explains its business model: “We wanted a fresh and unique way to show our love for Traverse City and Michigan, rather than having to resort to wearing low quality, boring and mass produced touristy t-shirts. So, we decided to create original, locally inspired designs and print them on the highest quality and most comfortable garments we could find.”).)

Because these items are fairly inexpensive, it is likely that they will be the subject of less sophisticated, impulsive purchases. As such, a likelihood of confusion exists. *See In re Am.*

⁵ Nov. 2015 Babcock Dec. Ex. A, p. 7; Registrant’s Mem., p. 6; Jan. 2016 Babcock Aff. Ex. A; Gabrys Aff. Ex. E & Registrant’s Mem., p. 7; Jan. 2016 Babcock Aff. Ex. B, respectively.

Blanching Co., 2008 WL 3817085, at *4 (TTAB July 10, 2008) (“goods of the type involved herein are relatively inexpensive, and would be the object of impulsive purchases and frequent replacement. Applicant’s argument that the goods are targeted to different consumers, or that consumers are sophisticated, is irrelevant given the lack of any limitation in the identification of the goods”).

In addition, because it has been established that QBP and Registrant sell similar goods, it is presumed that the circumstances under which the goods are purchased are the same:

where the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, **and that the goods would be purchased by all potential customers.**

In re Elbaum, 211 USPQ 639, 640 (TTAB 1981) (emphasis added). This factor weighs in favor of QBP’s Petition to Cancel.

5. *QBP’s marks have relative fame, in light of assessing the sales, advertising, and years of use of the marks.*

The next *DuPont* factor, “[t]he fame of the prior mark (sales, advertising, length of use),” weighs in favor of QBP. *DuPont*, 476 F.2d at 1361. Registrant does not address this factor in its Brief. (See Registrant’s Mem., p. 8.) “A famous mark is one that has extensive public recognition and renown.” *Pottle Prods. Inc. v. Melanie Reed*, 2015 WL 910220, at *3 (TTAB Feb. 10, 2015). “Fame of an opposer’s mark or marks, if it exists, plays a ‘dominant role in the process of balancing the *DuPont* factors,’ ... and ‘[f]amous marks thus enjoy a wide latitude of legal protection.’” *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000)) (internal quotations omitted).

As a result of QBP's widespread use and expenditure of resources to promote the goods and services offered under its 45NRTH mark, as well as its dedication to high-quality goods, QBP has acquired significant goodwill in and to the mark. (Compl. ¶ 2; Patterson Dec. ¶ 15.) For example, QBP's boot designs have twice won international design awards at Eurobike. (Patterson Dec. ¶ 15 & Ex. F.) Registrant itself asserts that QBP "is described as the **largest distributor of bicycle parts and accessories in the bicycle industry.**" (Registrant's Mem., p. 2 (emphasis added).) Not surprisingly, a Google search of "45North" with an "O" (like Registrant's marks) provides results relating to QBP's products. (Patterson Dec. ¶ 10 & Ex. D.) In this role, QBP has the type of relative fame that supports a finding of likelihood of confusion under this *Dupont* factor.

Fame can be gauged by, "among other things, ... the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp.*, 293 F.3d at 1371. QBP has a more developed history of sales, advertising, and length of use in its mark. QBP's date of first use in commerce of the 45NRTH marks in connection with any goods (October 1, 2011), and QBP's date of first use in commerce of the 45NRTH marks in connection with clothing (March 12, 2012), both precede the Registrant's claimed date of first use in commerce in connection with any goods (April 19, 2013) by more than one full calendar year. In addition, as detailed above, QBP advertises its marks in its online sales catalog (Gabrys Aff. ¶¶ 11-18 & Exs. C-D), on its website (Gabrys Aff. ¶ 25 & Ex. N), and on its product hangtags (Gabrys Aff. ¶ 26 & Exs. O-P). (See also Patterson Dec. ¶ 12.) QBP has advertised its marks on its Facebook page (Gabrys Aff. Ex. Q), through Internet press releases (Gabrys Aff. Ex. R), and in magazines (Gabrys Aff. Ex. S; See also Patterson Dec. ¶ 12.) QBP has sponsored numerous events in North America,

including Michigan. (Patterson Dec. ¶ 13.) During these sponsored events, QBP typically provides products—including 45NRTH products—as prizes, and displays its 45NRTH marks (logos) on the event website and at the event’s venue. (Patterson Dec. ¶ 13.) Between June of 2012 and today, QBP has spent [REDACTED] in marketing expenses relating to its 45NRTH Goods. (Patterson Dec. ¶ 14 & Ex. E.) It is estimated that, to date, QBP has sold over [REDACTED] units of 45NRTH goods and that it will sell an additional [REDACTED] units of 45NRTH goods in 2016 alone. (Patterson Dec. ¶ 18.) Registrant, on the other hand, has only used her mark in one advertisement in a Michigan tourist map. (Registrant’s Response to Interrogatory No. 11.)

QBP’s 45NRTH marks have come to represent the highest quality goods as used in connection with those goods, and consumers have come to count on QBP’s 45NRTH marks to represent superior clothing, footwear, and headwear complimentary to its bicycle parts and bicycling gear products. (Gabrys Aff. ¶¶ 5-7.)


6. *There are no other same or similar marks in use on similar goods.*

The sixth *DuPont* factor, “[t]he number and nature of similar marks in use on similar goods,” weighs in favor of QBP. *DuPont*, 476 F.2d at 1361. To QBP’s knowledge, QBP and the Registrant are the only two entities selling similar goods under similar marks. Notably, a search of USPTO records for applications and registered trademarks showed that the only marks registered in the USPTO including the numeral “45” and the term “NORTH” or “NRTH” are Registrant’s Registration Nos. 4,496,120 and 4,414,967 and QBP’s Reg. No. 4,268,136. (Jan. 2016 Babcock Aff. Ex. C (Table of Coresearch® Search Results).)⁶

⁶ Based on the most current information retrieved from the Coresearch®-Brand online screening software, the only applications pending in the USPTO for marks including the numeral “45” and the term “NORTH” or “NRTH” are QBP’s pending Application Nos. 86/232,330 and 86/232,342, and Application No. 86/805,493 for the mark 45 NORTH owned by 45 North Properties, Inc. (the “45 North Properties Mark”). (Jan. 2016 Babcock Aff. Ex. C.) The 45 North Properties Mark was applied for in connection with various real estate services in

Therefore, QBP and the Registrant are the only two entities with federal trademark registrations, or applications pending in the USPTO, for similar marks in connection with similar goods. When there is no evidence of third-party use of similar marks on similar products, such fact weighs in favor of a finding of likelihood of confusion. *See In re Marichem Marigases Hellas Ltd.*, 2003 WL 169756, at *4 (considering this factor in its likelihood-of-confusion analysis). QBP is entitled to summary judgment on its Petition to Cancel.

7. *The Examiner found there to be a likelihood of confusion between the marks.*

In addition to the specific factors set forth in *DuPont*, there is a final, catch-all factor: “[a]ny other established fact probative of the effect of use.” *DuPont*, 476 F.2d at 1361. The examiner already found a likelihood of confusion. QBP’s Trademark Application Nos. 86/232,342 and 86/232,330 were both refused registration on the basis of a likelihood of confusion with the marks of Registrant’s Reg. Nos. 4,496,120 () and 4,414,967 (**45NORTH**). (Jan. 2016 Babcock Aff. Exs. F & G (Office Action of App. Ser. No. 86/232,342; Office Action of App. Ser. No. 86/232,330).)

In the May 31, 2014 Office Actions, the Examining Attorney stated that, in connection with the likelihood of confusion refusals of QBP’s applications, the following factors were most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. (Jan. 2016 Babcock Aff. Ex. F, p. 2 & Ex. G, p. 2.) The Examining Attorney stated that “[s]pecifically, the goods are the same, namely clothing which is similarly mostly casual or informal. The marks themselves give similar commercial impressions of referring to the latitude of 45 degrees north, an arbitrary reference to clothing in general. The focus is on the recollection

International Classes 35 and 36. (*Id.* at Ex. D (Copy of TESS Record for App. No. 86/805,493).) The real estate services of the 45 North Properties Mark are dramatically different from the goods of QBP and the Registrant.

of the average purchaser, who normally retains a general rather than specific impression of trademarks.” (Jan. 2016 Babcock Aff. Ex. F, p. 2 & Ex. G, p. 2 (citing *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).)

On January 27, 2015, action on Application Nos. 86/232,342 and 86/232,330 was suspended pending resolution of the present cancellation proceeding. (Jan. 2016 Babcock Aff. Exs. H & I (Suspension Notice of App. Ser. No. 86/232,342; Suspension Notice of App. Ser. No. 86/232,330).) Both applications remain suspended. (Jan. 2016 Babcock Aff. Exs. J & K (TSDRs for Application Nos. 86/232,342 and 86/232,330).) The Board should follow the Examiner’s lead in finding that a likelihood of confusion exists and should, therefore, grant summary judgment in favor of QBP on its Petition to Cancel.

IV. CONCLUSION

For the reasons set forth herein, QBP respectfully requests that the Board deny Registrant’s Motion for Summary Judgment and instead grant summary judgment in favor of QBP on its Petition to Cancel.

Dated: January 22, 2016

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing was served via regular U.S. Mail this 22nd day of January, 2016 upon the following:

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